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EXAMINER

LE, DAVID Q

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 01/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/703,231

Applicant(s)

PINTSOV, LEON A.

Examiner

David Q Le

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2-4. 6) ☐ Other: .

Art Unit: 3621

DETAILED ACTION

Examiner's Note

1. Examiner has pointed out particular references contained in the prior art of record in the body of this Action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is requested from the Applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Drawings

2. The drawings are objected to because of significant errors or omissions, as listed below. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. These objections to the drawings will not be held in abeyance:

(a) Fig 1 should be designated by a legend such as "Prior Art" because only that which is old and well known in the art is illustrated. See MPEP § 608.02(g).

(b) In Fig 2, "Mail Item Files" should be labeled "200" as recited in the disclosure (p. 11, line 14).

(c) In Fig 3, "Mail Item File" block representation is mislabeled; instead of "300" it should be "200". "300" is "Third Party Computer", according to disclosure (p. 11, line 17). The disclosure also refers to "a list 318 of special services requested" (p. 12, lines 2-3); no such "318" label can be found in Fig 3. "Email addresses 320" (according to disclosure, p. 12, line 3) has no such label "320", and "Address (s)" is spelled incorrectly.

(d) In Fig 5, a step "425" is recited in disclosure (p. 13, line 18) but is not present in drawing.

(e) Figs 6A and 6B - as described in disclosure (p.13, line 20) - consist of one drawing - Fig 6.

(f) Fig 7 is barely legible.

Specification

3. The disclosure is objected to because of the following informalities: references to drawings as described above.

Appropriate correction is required.

4. **Claims 5 and 14** are objected to because of the following informalities:

Claim 5: e) ii) *said set of data relating to said special service* - lacks the ii) numbering.

Art Unit: 3621

Claim 14: *b) archiving said file* - is missing.

Appropriate correction is required.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. **Claims 1 and 19** are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over any of **claims 1, 26, 27** of copending **Application No. 09/339,768**.

An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claims because the examined claim is either anticipated by, or would have been obvious over, the reference claims. See, e.g. *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

Although the conflicting claims are not identical, they are not patentably distinct from each other because **claims 1 and 19** of the instant Application would have been obvious from any of **claims 1, 26, 27** of Application No 09/339,768.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. **Claims 2-18, 20-23** are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over any of **claims 1, 26, 27** of copending **Application No. 09/339,768** in view of **Kara**, PCT Publication WO 99/21330.

Although the conflicting claims are not identical, they are not patentably distinct from each other because **claims 2-18, 20-23** of the instant Application would have been obvious from any of **claims 1, 26, 27** of Application No 09/339,768 in view of **Kara**.

This is a provisional obviousness-type double patenting rejection.

Art Unit: 3621

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1-23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sansone, US Patent No. 5,978,781 in view of Kara, PCT Publication WO 99/21330.

As per **claim 1**:

Sansone discloses:

A method for communicating a message relating to the delivery of a mail within a mailing system (Sansone: Abstract), the method comprising the steps of:

a) creating a set of data relating to a request for a special service (Sansone: Abstract: "...allow user to request specialty mailing services.."; Col 5, lines 10-13; Col 6, lines 30-34: "...return receipt requested.."),...;

b) evidencing said set of special service request data into a predetermined location on said mail piece (Sansone: Figs 1-4, associated text; Col 3, lines 6-26);

c) capturing from said predetermined location on said mail piece said set of data relating to said request for special service (Sansone: claims 15, 16, 17);

d) performing said captured request for special service (Sansone: claims 15, 16, and 17)

Sansone does not disclose:

a) ... including an electronic address;

e) creating a recipient response message, and

f) sending said message to said captured electronic address.

Kara discloses:

A method for communicating a message relating to the delivery of a mail piece within a mailing system (Kara: Abstract, Fig 1, associated text), the method comprising the steps of:

a) creating a set of data relating to a request for a special service (Kara: P23, L8-21), said set of data including an electronic address (Kara: P20, L3-7; P20, L23 – P21, L5);

b) evidencing said set of special service request data into a predetermined location on said mail piece (Kara: P20, L23 – P21, L5; P24, L25-28; P26, L12-17);

Art Unit: 3621

c) capturing ... said set of data relating to said request for special service (Kara: P12, L13-17; P15, L25 – P16, L5);

d) performing said captured request for special service (Kara: P6, L9-12; P12, L28 – P13, L2)

e) creating a recipient response message (Kara: P27, L7 – P28, L2), and

f) sending said message to said captured electronic address (Kara: P37, L15-22).

Kara further teaches that hard-copy documents or letters may be physically sent to his system's mail/data center for processing, either physically or electronically delivered, and confirmation of such delivery may be securely forwarded back to the sender (Kara: P12, L13 – P13, L2).

Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to combine the features of Sansone's invention with the system disclosed by Kara, in order to provide a convenient method for a sender to forward a hard-copy mail piece imprinted with indicia (containing a return email address) to a mailing service, have the mailing service deliver the mailpiece, and receive back a return receipt from the recipient via an email sent to that email address. Such a system would avoid lengthy delays before getting said return receipt; the method will clearly fall within the parameters taught by Kara, and would also meet all the limitations of Applicant's claim 1.

As per claim 5:

Sansone in view of Kara disclose all the limitations of claim 5 (see above citations, additional citations below):

A method for responding to the distribution of a mail piece within a mailing system, the method comprising the steps of:

a) creating a set of data relating to a request for a special service, said set of data including an electronic address;

b) incorporating said set of special service request data into a predetermined location on said mail piece;

c) obtaining from said predetermined location on said mail piece said set of data relating to said request for special service;

d) performing said obtained request for special service;

e) creating a message, said message including:

i) a set of mail piece data,

ii) said mail piece data including said set of data relating to said special service (Kara: P37, L7-21)

iii) an image of said mail piece (Kara: P27, L7-17);

iv) an image of a recipient signature (Kara: P17, L21-23; P36, L13-16);

v) a message from said recipient (Kara: P27, L19-11; P37, L19-20); and

Art Unit: 3621

f) sending said message to said obtained electronic address (Kara: P37, L7-21).

It would have been obvious to one ordinarily skilled in the art at the time the invention was made to combine the features of Sansone's invention with the system disclosed by Kara, in order to provide a convenient method for a sender to forward a hard-copy mailpiece imprinted with indicia (containing a return email address) to a mailing service, have the mailing service deliver the mailpiece, and receive back a return receipt from the recipient via an email sent to that email address. Such a system would avoid lengthy delays before getting said return receipt; the method will clearly fall within the parameters taught by Kara, and would also meet all the limitations of Applicant's claim 5.

As per **claim 12**:

Sansone in view of Kara disclose all the limitations of claim 12 (see above citations, additional citations below):

A method for employing digital postage mark as part of special services in a mailing system comprising the steps of:

a) creating a set of postal data required of postage payment evidencing of a mail piece (Sansone: Fig 4; Kara: Fig 4; associated text);

b) creating a set of special service data defining a special service for said mail piece, said set of special service data includes an electronic address;

c) creating a digital postmark including said set of postal data and said set of special service data;

d) encrypting said encrypted digital postmark (Sansone: Fig 4, associated description; Col 3, lines 49-60; Kara: P8, L1-10: "...transmitted document is encrypted..");

e) printing said digital postmark on said mail piece

f) processing said mail piece to obtain said digital postmark;

g) determining said special service from said digital postmark;

h) performing said special service;

i) creating a message, said message including:

- i) a set of mail piece data;*
- ii) said set of data relating to said special service;*
- iii) an image of said mail piece*
- iv) an image of a recipient signature;*
- v) a message from said recipient; and*

j) sending said message file to said obtained mailer address.

It would have been obvious to one ordinarily skilled in the art at the time the invention was made to combine the features of Sansone's invention with the system disclosed by Kara, in order to provide a convenient method for a sender to forward a hard-copy mail piece imprinted with indicia (containing a

Art Unit: 3621

return email address) to a mailing service, have the mailing service deliver the mailpiece, and receive back a return receipt from the recipient via an email sent to that email address. Such a system would avoid lengthy delays before getting said return receipt; the method will clearly fall within the parameters taught by Kara, and would also meet all the limitations of Applicant's claim 12.

As per **claim 19**:

Sansone in view of Kara disclose all the limitations of claim 19 (see above citations):

System for providing a message relating to the distribution of a mail piece within a mailing system comprising:

- a) means for determining, during said mail piece delivery, a set of information contained at a predetermined location on a mail piece, said set of information including an electronic address;*
- b) means for creating a message; and*
- c) means for sending said message to said electronic address.*

It would have been obvious to one ordinarily skilled in the art at the time the invention was made to combine the features of Sansone's invention with the system disclosed by Kara, in order to provide a convenient method for a sender to forward a hard-copy mail piece imprinted with indicia (containing a return email address) to a mailing service, have the mailing service deliver the mailpiece, and receive back a return receipt from the recipient via an email sent to that email address. Such a system would avoid lengthy delays before getting said return receipt; the method will clearly fall within the parameters taught by Kara, and would also meet all the limitations of Applicant's claim 19.

As per **claims 2, 20-22**:

Sansone in view of Kara disclose all the limitations of claims 1 and 19, respectively.
Kara further discloses (see citations used for claim 5):

... response message further includes:

- a) an image of said mailpiece (claims 2, 21);*
- b) a recipient response to a mailer (claims 2, 20); and*
- c) an image of a recipient signature (claims 2, 22).*

Sansone teaches that postal indicia imprinted on mail pieces may incorporate data representing requests for special services (i.e. a return receipt) and miscellaneous information other than postage fee. He also teaches that this data may be read by authorized mailing/data centers that will in turn perform the requested services, using the data incorporated in the indicia. Sansone does not teach that a return receipt may be delivered back to a sender via email, or that the sender's email address would be incorporated into the original postal indicia. In addition Sansone is silent on including an image of the mailpiece, a response from the recipient of the mailpiece, and an image of the recipient's signature in the return receipt.

However Kara does teach that (1) communications between sender/recipient of mail pieces and authorized mailing/data centers may be accomplished via email, fax, physical, hard-copy deliveries, or any other reasonable medium; (2) that return receipts or delivery confirmations may be provided to a sender with images of the original mailpiece and of the recipient's signature, along with a response from the recipient.

Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have combined Sansone's and Kara's teachings in order to achieve a highly secure,

Art Unit: 3621

reliable, yet speedy method for providing incontrovertible proofs of delivery to senders of important documents. Such a system would meet all the claim limitations as cited above.

As per **claims 3, 6, 14, 23**:

Sansone in view of Kara disclose all the limitations of claims 1, 5, 12, and 19, respectively.

Kara further discloses (Kara: P9, L12-21; P10, L5-8):

..including the steps of:

a)creating a file including said recipient message; and

b)archiving said file.

Sansone does not disclose the above limitations.

However Kara teaches that a preferred embodiment of his system includes archiving records of all documents transmitted between senders and recipients, to allow future retrieval and verification, should the need arise.

Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have further included in a mailing system as disclosed in claims 1, 5, 12, and 19, the archiving of all transmitted documents, including recipients' messages. This would have been one further step in providing proofs of delivery that couldn't be challenged, because a trail of reproducible transmissions would be available for retrieval and verification. Such a system would meet all the limitations of claims 3, 6, 14, 23.

As per **claim 7**:

Sansone in view of Kara disclose all the limitations of claim 5.

Both Sansone and Kara further disclose (see citations used for claim 1):

.. predetermined location is a digital postmark.

As per **claims 4, 8, 15**:

Sansone in view of Kara disclose all the limitations of claims 1, 5 and 12, respectively.

Kara further discloses (Kara: Fig 1, associated text; P20, L3-7; P20, L23 – P21, L5; P37, L15-22):

.. electronic address is an email address.

See obviousness/motivation analysis for claims 2, 20-22. Additionally it would have been obvious to one of ordinary skill in the art at the time the invention was made that email addresses would be a preferred electronic address to use, because of the increasing popularity of the Internet, its ease of use, and the quasi-immediate delivery of messages using this communication medium.

As per **claims 9, 16**:

Sansone in view of Kara disclose all the limitations of claims 5 and 12, respectively.

Kara further discloses (Kara: Fig 1, associated text; P8, L19-21; P20, L3-7; P20, L23 – P21, L5; P37, L15-22):

.. electronic address is a facsimile number.

Art Unit: 3621

See obviousness/motivation analysis for claims 2, 20-22, 4, 8, 15. Fax numbers are less convenient than email addresses but would still be faster to use than physically delivering documents, and therefore are obvious alternative electronic addresses to include.

As per claim 10:

Sansone in view of Kara disclose all the limitations of claim 5.

Kara further discloses (Kara: P6, L9-12; P37, L15-22):

..special service request is an electronic confirmation of receipt.

Sansone did not disclose an "electronic" confirmation of receipt. But Kara did teach that capitalizing on the latest electronic communication technologies was key in the preferred implementation of his system. Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have modified Sansone's system with Kara's teaching in order to provide the most efficient, most speedy delivery of a return receipt.

As per claim 11:

Sansone in view of Kara disclose all the limitations of claim 5.

Kara further discloses (Kara: Fig 1, associated text; P37, L15-22):

.. special service request is an electronic communication.

See obviousness/motivation analysis for claim 10. It would have been obvious to one ordinarily skilled in the art to have applied the same reasoning to modify Sansone's system to allow special service requests to consist of any of several electronic communications: proof of transmission, tracking report, return receipt, etc. These various electronic communications would all be useful and desirable, because they would provide to senders more visibility of their documents' transmission, from start to end.

As per claim 13:

Sansone in view of Kara disclose all the limitations of claim 12.

Sansone and Kara further disclose (Sansone: Fig 4, associated description; Col 3, lines 49-60; Kara: P8, L1-10: "...transmitted document is encrypted.."):

.. the steps of:

a) decrypting said digital postmark; and

b) determining mail piece validity by verifying said digital postmark

As per claim 17:

Sansone in view of Kara disclose all the limitations of claim 12.

Sansone and Kara further disclose (see citations already used above):

.. special service is confirmation of receipt.

As per claim 18:

Sansone in view of Kara disclose all the limitations of claim 12.

Kara further discloses (Kara: P9, L28 – P10, L8: "...independent third party confirmation of delivery..; ..proof of transmission/delivery ..provided by a trusted third party.."):

Art Unit: 3621

.. special service is a third party communication.

Sansone does not disclose this limitation. However Kara teaches that any number of third parties may be involved in the transmission of a document from a sender to a final recipient. Therefore it would have been obvious for one ordinarily skilled in the art at the time the invention was made to have allowed such requests for third party communications, in order to accommodate tracking the progress of said document from point to point, either physically, electronically, or logically (i.e. a payment/authorization confirmation from a third party vendor/authority). Such a system would be more attractive to users and meet the further limitation of claim 18.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q Le whose telephone number is 703-305-4567. The examiner can normally be reached on 8:30am-5:30pm Mo-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-8494 for regular communications and 703-746-8494 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

DQL

January 23, 2003

JOHN HAYES
John V. Hayes
Primary Examiner